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U.S. Appln No. 10/720,005

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(Attorney's Docket No. h-203754)

Confirmation No. 3992

Inventor: Matthew Howard Fronk

Art Unit: 1795

TITLE: CORROSION RESISTANT
PEM FUEL CELL

Examiner: Tracy Mae Dove

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This is Appellant's Reply Brief in response to the Examiner's Answer of May 11, 2009.

In summary, the Examiner's Answer takes the position that the board should confirm the rejection of claims 9-172 under 35 U.S.C. 251 based on a number of the Examiner's "findings of fact" and "conclusions of law". Appellants maintain that these "findings of fact" and "conclusions of law" constitute reversible error and request the board to reverse the rejections of claims 9-172 in Appellants' application.

First, the Examiner's rejection is based upon an erroneous finding of fact that there was no intent to broaden presented within two years of the patent date (see Examiner's answer page 3, lines 13-15). Second, the rejection is based upon an

erroneous conclusion of law that there is a requirement for a statement or clear indication to be in the declaration filed in a broadening reissue within two years of the patent grant (See the Examiner's answer page 3, lines 19–22). Third, the rejection is based upon an erroneous finding that the public was not placed on notice that a broadening reissue was being filed within two years of the grant of the original patent (See the Examiner's answer page 4, lines 5–7). Fourth, the rejections based upon an erroneous conclusion of law based upon the nonbinding Manual Patent Examiner's Procedure (MPEP) that there is a requirement that a broadened reissue claim is a claim which is greater in scope than each and every claim of the original patent (See the Examiner's answer in the paragraph bridging pages 4 and 5). Fifth, the rejection is based upon the erroneous finding that because both claim 1 and claim 8 include the limitation “a resistivity no greater than about 50 ohm-cm” that claim 1 is not broader than claim 8 as set forth in the amendment filed on November 21, 2003 and therefore a broadening reissue application had not been filed (See the Examiner's answer at page 5, line 9–page 6, line 4).

THE REISSUE STATUTE 35 U.S.C. 121 IS REMEDIAL IN NATURE.

The Federal Circuit has held that “[i]n enacting [§ 251], congress provided a statutory basis for correction of “error” the statute is remedial in nature, based upon fundamental principles of equity and fairness, and should be construed liberally.” In re Weiler, 790 F.2d 1576, 1579 (Fed. Cir. 1986). Liberal construction and remedial application of the statute 35 U.S.C. § 251 occurred in Medrad, Inc. v Tyco Healthcare Group LP. et al., 466 F.3d 104, 80 USPQ 2d 1526 (Fed. Cir. 2006). During prosecution of a reissue application, Medrad narrowed the scope of various claims (correcting and

“overclaiming” error) and corrected inventorship in addition to correcting an underclaiming error but Medrad did not submit a supplemental reissue declaration regarding the overclaiming or inventorship errors as required under 35 U.S.C. § 1.175. The Federal Circuit held that correction of errors under 35 U.S.C. § 251 was not limited to errors in the specification or claims and that the statute could be used to correct inventorship and to correct failure to submit a supplemental declaration.

In re Bennett, 766F. 2d 524 (Fed. Cir. 1985) involved a broadening reissue application which was filed within the two-year period for such applications seeking to enlarge the scope of claims but was defective because it was not executed by the inventor, but was instead executed by the assignee. The issue before the court was whether the defective execution in a timely filed reissue application may be corrected after the two-year period has passed for filing a broadening reissue application. The Federal Circuit recognized that portions of § 251 require that broadening reissues must be signed by the inventor, but concluded that compliance with § 251 is not insulated from remedial application of the statute. The Federal Circuit noted the purpose of the reissue statute was to remedy errors citing Ball Corp v United States, 729 F. 2d 1429, 221 USPQ 289 (Fed. Cir. 1984) (“reissue is remedial in nature and is based upon fundamental principles of equity and fairness”). In holding that the Board erred in refusing to allow the Appellant to correct the defective execution of a reissue application which is filed within the two year period required by 251, the Federal Circuit took note of the fact that 35 U.S.C. § 26 allowed for the Commissioner to accept a defectively executed application provided a properly executed document is submitted within such time as may be prescribed.

In the instant application, the Examiner admits at page 3, lines 9–11 that Appellants did submit a statement that the reissue is a broadening reissue in the second preliminary amendment filed October 20, 2004. Appellants maintain that there is absolutely no requirement under 35 U.S.C., 37 CFR or in the case law for Appellants to make a statement that a reissue application is a broadening reissue application prior to the expiration of two years after the patent. And to the extent that there is such a requirement, Appellants' statement in the second preliminary amendment meets such requirement and the remedial nature of 35 U.S.C. 251 dictates that such is sufficient and would be consistent with the holding and In re Bennett.

APPELLANT FULLY COMPLIED WITH 37 CFR 1.175.

Appellants maintain that there is absolutely no requirement for Appellants to make a statement that a reissue application is a broadening reissue application and that Appellants original reissue oath met the requirements of 37 CFR 1.175(a)(1) which states that the reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The Appellants believes the original patent to be wholly or partially inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had a right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and...

Appellants' original declaration transmittal form included a statement that:

The amendment to claim 1 corrected an inadvertent error in claim

1. The word "no" should have been in the claim when the limitations of claim 12 were incorporated into claim 1 by the amendment "paper number 4" dated June 25, 2001 during the prosecution of United States patent number 6,372,376.

Nothing more is required under 37 CFR 1.175. Contrary to the USPTO form PTO/SB/51 and the Examiner's position, there is no requirement under statute, the CFR or the case law for Appellants to make a statement that the reissue application is a broadening reissue application. And in any event, Appellants maintain the above statement in combination with the fact that Appellants included the word "no" in claim 1 drastically changed the scope of claim 1 making it broader than claim 1 as presented in the issued patent. The fact that Appellants filed the reissue application within the two year period for a broadening reissue, the fact that Appellants filed the application with declarations by the inventor and not by the assignee as required for broadening reissue, and the fact that claim 1 as set forth in the reissue application is indeed broader than claim 1 as set forth in the issued patent, are clear indications that Appellants intended to file a broadening reissue application and the public was properly put on notice.

THE REJECTION IS BASED UPON AN ERRONEOUS APPLICATION OF LAW
AND MISGUIDED USE OF MPEP 1412.03.

In response to Appellants assertion that the Examiner has provided no authority for taking position that a broadening reissue application must include a claim that is broader than every claim in the issued patent, the Examiner relies on MPEP 1412.03, § 1, and takes the position that such sets forth that a broadening reissue claim is a claim which enlarge the scope of the claims of the patent, i.e., a claim which is greater in scope than each and every claim of the original patent. Appellants maintain that the MPEP is not binding law. The proper test as to whether a claim is broader is set forth In re Bennett, at 525–526 which held that a claim is broader if it is broader in any respect than [the] original claim, even though it may be narrow in other respects. As set forth in Appellants Appeal Brief, any amended or newly added claim in a reissue application which contains within it's scope any conceivable product or process which would not have infringed the issued patent, then that reissue claim would be broader than the patent claims. Tillotson, Ltd. v Walbro Corp. 831 F.2d 1033, 1037 (Fed. Cir. 1987). In the instant application claim 1 as amended in the reissue application is broader than claim 8 because claim 8 includes additional limitations not found in claim 1 as specified in Appellants Appeal Brief.

Even though Appellants maintain that there is no case law that requires at least one reissue claim to be broader than each and every claim of an original patent for the reissue application to be a broadening reissue, Appellants have nonetheless complied with such a requirement. That is, Appellants filed claim 1 in the reissue application

which was broader than claim 1 and claim 8 in the issued patent in at least one respect even though claim 1 may be narrower than claim 8 in some other respect.

The Examiner's finding that both claims 1 and claim 8 include the limitation "a resistivity no greater than about 50 ohm-cm" means that claim 1 as amended on 11/21/03, is not broader than patent claim 8 is simply incorrect. Again, claim 8 includes a number of limitations not found in claim 1 and therefore claim 1 is broader at least in some respects than claim 8 and therefore is a broadening claim. See In re Bennett, 525-526.

APPELLANTS USE OF THE TERM "INADVERTENT ERROR"

IS NOT INCONSISTENT WITH AN INTENT TO FILE A

BROADENING REISSUE APPLICATION.

The Examiner, at page 4 of the Answer, attempts to make much of Appellants use of the term "inadvertent error" as set forth in the transmittal page of the inventors' declaration. The use of the term "inadvertent error" is not used to diminish the nature of the error being corrected with respect to claim 1 or in any way to indicate that the error being corrected in claim 1 was anything but an error which resulted in a broadening reissue claim. The term "inadvertent error" is a term of legal significance meaning that the error attempting to be corrected is the type of error authorized under 35 U.S.C 251. The term "inadvertent error" was used in the case law before the enactment of the 1952 act with respect to the type of error that a reissue application could be applied for. With reference to the 1952 act, Congress did not intent to alter the test that existed prior to the act that an "inadvertence, accident, or mistake" was being corrected by the reissue application as opposed to a "conscious choice" which is not the type of error that could

be corrected by reissue. See In re Weiler, 790 F.2d 157, (Fed. Cir. 1986). Because the rejection is based upon the fact that Appellants used the term “inadvertent error” and did not include a literal statement of intent to file a broadening reissue, such is reversible error.

Because the rejection is based upon a number of erroneous findings of fact or conclusions of law, the rejection of claims 9–172 is based upon reversible error. Appellants respectively request the board to reverse the Examiner’s rejection of claims 9–172.

Respectfully submitted,

A handwritten signature in cursive script, reading "Cary W. Brooks", is written over a horizontal line.

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CWB/br